PATENT
Attorney Docket No. ANA-5955 (3360-0083)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Trillo, et al.

Serial No.: 10/682,303

Filed: October 9, 2003

Art unit: 1617

Examiner: Leonard M. Williams

For: Method for Cardioprotection and Neuroprotection by Intravenous Administration of Halogenated Volatile Anesthetics

The undersigned hereby certifies that this correspondence is being filed with the Electronic Filing System of the United States Patent and Trademark Office on the date indicated below:

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Commissioner for Patents
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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action (restriction requirement) of January 16, 2007 in the above-identified patent application, Applicants provisionally elect the claims of Group I (Claims 1-12) with traverse, and respectfully request that the Examiner reconsider and withdraw the restriction requirement for the reasons set forth below. In the event that the restriction requirement is not withdrawn, Applicants reserve the right to pursue the non-elected claims of Groups II - IV (Claims 13-25) in later applications.

The examiner indicates that while the groups of claims are related, they are also distinct. According MPEP § 806.05(j) the inventions are distinct if (a) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; (b) the inventions as claimed are not obvious

variants; and (c) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. In other words, all three criteria must be established for the inventions to be held as distinct and requiring a restriction. Applying these standards to the present group of claims, the Office Action holds that the claims are drawn to differing methods of treating for differing events (ischemia, myocardial infarction, neural ischemia), the methods can be accomplished in a variety of ways including treatment with vasodilation agents, blood pressure therapy, etc. and the methods do not encompass overlapping subject matter.

It is clear however that while the methods of treatment may be accomplished in a variety of ways, the claims do not recite this. All the claims recite treating a patient comprising parenterally administering a formulation comprising a halogenated volatile anesthetic. All the claims require this feature. Applicants respectfully submit that the subject matter of the Group I claims is sufficiently related to the subject matter of the claims of Groups II-IV to allow for examination of all of the claims together.

In addition, one of the above criteria of distinctness is that the inventions do not overlap in scope, i.e. are mutually exclusive. In other words, the inventions cannot be mutually exclusive if there is a product or process that would infringe one or more of the grouped inventions (See Examiner's note in MPEP § 806.05(j)). This criterion is lacking.

Group I claims are directed to a method of treating a patient having a tissue that is subject to an ischemic event, comprising **parenterally administering a formulation comprising a halogenated volatile anesthetic to the patient**, among other things. Group II claims are directed to a method of treating a patient having myocardial tissue that is subject to an ischemic event, comprising **parenterally administering a formulation comprising a halogenated**

volatile anesthetic to the patient, among other things. Group III claims are directed a method of treating a patient having myocardial tissue that is subject to a myocardial infarction, comprising **parenterally administering a formulation comprising a halogenated volatile anesthetic to the patient**, among other things. Group IV claims are directed a method of treating a patient having neuronal tissue that is subject to an ischemic event, comprising **parenterally administering a formulation comprising a halogenated volatile anesthetic to the patient**, among other things. Plainly, the scope of claim 1 overlaps with claim13 since "myocardial tissue" is within the scope of the broad term "tissue". Therefore, since Group I and II claims are not distinct, no restriction should be required.

The same rationale applies to Group I and Group IV claims. The scope of claim 1 overlaps with claim 22 since "neuronal tissue" is within the scope of the broad term of "tissue". Therefore, since Group I and IV claims are not distinct, no restriction should be required.

In addition, Group II and IV are species of the broader genus Group I claims. Indeed, if Group I claims are found allowable Group II and IV claims would also be allowable. 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby and 37 CFR 1.146 states that the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application. Since applicants have shown that claim 1 is a generic claim to the species of Group II and IV applicant should be allowed to select at least one species group to

examine with the generic group. Accordingly, applicants should be allowed to elect Group I and II.

According to the Election/Restriction Requirement, Group I and IV claims are classified in class 514, subclass 816. This should warrant examining these claims together. Indeed it is difficult to see how such a single examination would create any serious burden on the Patent Office and Applicants submit that a single examination may even be more economical.

Furthermore, since claim 1 is a linking or genus, applicants are allowed to select at least one additional species to examine with the genus as indicated in 37 CFR 1.141 and 1.146. Applicants as stated above would elect Group II. According to the Election/Restriction Requirement Group II claims are classified in class 514, subclass 743. Since Group III is also classified in the same class and subclass, this should warrant examining these claims together. As indicated above, this should not create any additional burden and may even be more economical.

For the reasons given above, Applicants respectfully request reconsideration and withdrawal of the restriction requirement entirely. If the restriction requirement is not entirely withdrawn, at the very least applicants submit that in view of the foregoing, a four-way restriction is not necessary. At minimum Groups I and II should be examined together and preferably Groups I, II and IV should be examined together. If the four-way restriction is ultimately maintained, Applicants elect Group I.

It is believed that no fees are due with this response. If however fees are required, the Commissioner is authorized to charge deposit account 50-1039 for any of these fees.

Respectfully submitted,

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